

REMARKS

The Claim currently under consideration is Claim 13. Upon grant of the present request for reconsideration and reinstatement of the previously considered Claims 1, 3, 4, 6, 7, 11, 12, and 14-25 as requested herein, the Claims under consideration would be 1, 3, 4, 6, 7, and 11-25 as listed above. Claims 1, 14 and 15 are labeled “(withdrawn/currently amended)”¹ and shown as Applicants would like said Claims to be presently amended.

Independent Claim 13 has been amended to make clear that the claimed method for producing elastic areas occurs on a properly denominated web of precursor garments. Currently-withdrawn Independent Claims 1, 14 and 15 have been likewise amended. This amendment is supported in the specification by at least Figs. 2-4 and the accompanying written text in the specification. The use of “continuous line” in the claims has been deleted as being generally redundant with the usage of “web.” No new matter is presented hereby. The Detailed Action of 03 November 2004 will now be addressed with reference to the headings and any paragraph numbers therein.

Election/Restrictions

Per paragraph 1 of the Detailed Action, Claims 1, 3-4, 6-7, 11-12 and 14-25 are “withdrawn as being drawn to a nonelected species, there being no allowable generic or linking claim.”

Applicants request reconsideration of the withdrawal of Claims 1, 3-4, 6-7, 11-12 and 14-25 and reinstatement of said Claims because the action of, and stated basis for, this withdrawal is incorrect substantively and procedurally.

¹ Per the Examiner’s direction from a telephone conference with Applicants’ undersigned attorney on 06 December 2004.

The species to which the Claims were previously restricted is that of such methods as may be illustrated by the exemplary Figs. 2-4 and making use of “non-treated elastic material” [see paragraph 4 of the Detailed Action of 06 January 2004 and Applicants’ Amendment A, page 9, last paragraph]. However, according to the present Detailed Action at paragraph 1: “these [withdrawn] claims now claim a method of producing elastic cuffs for a resultant garment from a precursor garment, (emphasis in the original) ... these claims now appear to drawn [sic] to an otherwise completed individuated precursor garment, not at least one continuous layer of a web of precursor garments as shown in the elected species of Figures 2-4.”²

The Detailed Action has put forth no reasonable grounds to explain why the withdrawn Claims no longer fit within the species. Nor has a reasonable explanation of how the present claims can be deemed to be article or apparatus claims been put forth by the Detailed Action. The Claims, with respect to the basis of the species selection, had not been substantively changed by the previous Amendment B. Each of Claims 1, 3-4, 6-7, 11-12 and 14-25 had only been changed by previous Amendment B to refer to a “precursor garment” rather than “precursor garments.”³ Under long standing rules of claim construction, a limitation to one “precursor garment” must encompass a plurality of “precursor garments” (e.g., as contained in a web of precursor garments being carried on a converting line), as claimed previous to Amendment B and admitted by the Office to be contained within the species. Further, each of Independent Claims 1, 14 and 15 referred in their preambles to the method as

² Applicants note that the Detailed Action asserts within one sentence that the withdrawn Claims are drawn to a method and then asserts the Claims are drawn to an article of manufacture. Applicants further note that Fig. 4 shows both a web of precursor garments and a resultant garment to illustrate the claimed methods. Clarification is requested in a further non-final Office Action should further action be necessary.

³ This was done to cure the §112 rejections of the Office Action of 05 May 2004 wherein the Examiner complained: that “it is unclear how many garments and how many [sic] cuff areas at a minimum are being claimed.” (See further explanation of Amendment B at its page 20, 1st paragraph therein.)

taking place “on a continuous line” rather than occurring on individuated garments. It would reasonably be understood by one of skill in the art that a continuous line would refer to a web of garment materials. However, in order to facilitate prosecution of the present application, Applicants have amended the claims to refer to a web of precursor garments occurring within the claimed methods rather than a precursor garment occurring on a continuous line. Each Claim withdrawn by the Detailed Action was previously, and continues as amended hereby, to fall within the originally elected species.

Procedurally, this withdrawal of claims is an *ex post facto* action which has been made without a proper restriction requirement having been issued under 37 CFR 1.146. The previous election of 12 February 2004 was an election of a claim group and a species under the then-stated circumstances and cannot give the Examiner license to withdraw claims *ex post facto* without a proper restriction requirement. The Detailed Action is further incorrect in stating that the previous election was made without traverse in “Paper No. 2-12-2004 (sic).” The Election was made with traverse and reasons were given for such traverse, although the Examiner later deemed the election to be made without traverse. At that time, Applicants chose not to engage in argument over the grounds of traverse in order to advance the progress of the application’s prosecution. However, Applicants strenuously traverse the present withdrawal of claims.

For all the foregoing reasons reconsideration of the withdrawal of Claims 1, 3-4, 6-7, 11-12 and 14-25 and reinstatement thereof is believed to be appropriate and is respectfully requested. Further, upon reinstatement, it is requested

that the Office amend said Claims as listed herein, or conversely, upon amendment of said Claims, it is requested that the Claims be reinstated and properly examined.

Drawings

Applicants acknowledge approval of the amended drawings and thank the Examiner.

Description

Per paragraph 3 of the Detailed Action, “substrate” at line 10 of the Abstract has been changed to - -component- -. Applicants note that there is no further discussion of the Abstract within the Detailed Action although there is a reference to “discussion infra” within paragraph 3. Clarification is requested.

Per paragraph 4 of the Detailed Action, registered trademark symbols have been placed next to the complained of terms.

Per paragraph 5 of the Detailed Action, corrections have been made as suggested by the Examiner in subsection 1).

Per paragraph 5, subsection 2, of the Detailed Action, the Examiner complains of confusion as to the meaning of “precursor garment.” A precursor garment has been consistently taught as some part or combination of parts (whether said part be a web, a component (of the garment), a layer (of the garment), or a substrate (such as a web to which other components are attached), or an assembly of materials which is then placed within a web) used on the line (i.e. the line handling the web of precursor garments during the act of assembly, i.e., at that time of assembling the web of precursor garments; and before the garment is finished as a commercially ready product.

Consider, it would be generally understood that the term “cuff area” has meaning only in relation to a garment, but to a person of skill in the art of disposable garment manufacture, the term “cuff area” can apply whether said garment is in its identifiable garment component pieces, i.e., in an inchoate state, or the term “cuff area” will, of course, apply when the garment is completed.

It would be apparent to anyone of skill in the art that any resultant garment must, at some point, be made according to the process of the present invention from a web of identifiable but unassembled component pieces (representing the inchoate, or precursor, garments) in order to obtain the resultant garment.

Therefore the terms “precursor garment” or “precursor garments” represent those identifiable parts of the inchoate garment existing within the web. The terms “precursor garment” or “precursor garments” thus differentiate identifiable areas of garment components while the garment is still in the act of being made, from those areas of the resultant garment where the method is completed, thereby establishing an order to the method of the present claims. The definition presented within the specification is consonant with this meaning.

Applicants have also used the terms “cuff area,” “conversion (or continuous) line,” precursor garment” and “resultant garment” in order to clearly teach and claim the garment-making methods of the present invention as distinguished from the general making of elasticized webs.

The Detailed Action evidences a fundamental misunderstanding of the invention by insisting on a further definition of a “precursor garment” rather than seeking to understand the presently claimed methods’ limitations in terms of a

manufacturing process; which by its nature would encompass a product flow and counterpart physical manifestations.

Any person having ordinary skill in the art and process of automated garment manufacture would understand the process-driven limitations and thus would have no trouble understanding the meaning and import of the claim limitation verbiage.

Particularly, it appears that the Examiner has misinterpreted the definition of “precursor” (at page 11 of the specification as previously amended⁴) to somehow include assembly apparatuses, i.e., machinery, used in the making of a garment as a component of the Claims.⁵ The Detailed Action then carries forward said misinterpretation when the word “precursor” is used to modify “garment” to conjure a chimera of inconsistency stating: “therefore, that the terminology ‘precursor’ in combination with the terminology “garment” now also appears inconsistent, i.e. apparatuses for making versus product made.” (Detailed Action page 4, line 2). Instead, the Examiner should have used contextual information from the specification to reasonably and properly conclude that the “components, materials, assemblies, or the like” are those pieces which can go into the make up of the actual garment.⁶

The Detailed Action further complains that “this lack of clarity is exacerbated by the apparent use of multiple terms for the same thing.” (Detailed

⁴ Applicants note that the Detailed Action asserts that Applicant has redefined “precursor” by Amendment B. Applicants disagree. They merely attempted to clarify “precursor” in response to the Examiner’s numerous objections in the Office Action of 2/12/04.

⁵ It appears to Applicants that an unreasonably broad definition has been given by the Office to the words “components and assemblies.”

⁶ Per MPEP §2101.01, the PTO is to apply “to verbiage of the proposed claims the broadest reasonable meaning...taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” [emphasis added] from *In re Morris*, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Action, page 4, line 11). It is respectfully submitted that during the converting process any of multiple items or components (being denominated by multiple terms) may be introduced to construct the garment which, at a point prior to completion of a commercially ready garment, may ultimately be described as a “web” of precursor garments. Many of these components may be described in different fashion, e.g., webs can be substrates which have other materials or components added thereto to be built into assemblies, and the like. The language of the art admits of such variants to a reasonable degree and the present usage would be understood by the person having ordinary skill in the art.

As properly understood and interpreted, it is therefore respectfully submitted that there is no confusion nor need for further correction of the specification’s description.

Claim Language Interpretation

The Examiner’s interpretation of the terminology “a continuous line” is rendered moot by the amended claim language and discussion herein which now more clearly denominate the claimed methods as operating on a web of (identifiably) precursor garments to produce the commercially ready resultant garment. It is noted that the present claims would not read on the making of a generally or generically elasticized web *per se*, which might be rolled, stored, and later re-introduced into a manufacturing process.

Claim Rejections – 35 USC § 102

Per paragraph 8 of the Detailed Action, Claim 13 stands rejected under 102(b) as anticipated by US Patent 5,588,155 to Baker et al. (hereinafter “Baker”) or US Patent 5,336,545 to Morman.

Without implication as to the meaning or breadth of claims in the cited references, neither of Baker or Morman teach a method of application of an elastic on a necked web having a precursor garment, as taught and claimed in the method of the present invention. It is therefore respectfully requested that the present rejections be withdrawn.

Specifically with respect to Claims 7, 16 and 21 concerning flat cuff areas, Baker shows only gathered, rugose, or shirred cuffs in the unstretched resultant garments of its Figs. 3 and 5, unlike the limitations of present claims. Morman appears to give no specific teaching with respect to cuff areas of garments.

For all the foregoing reasons the Claims as presently amended are believed to be allowable over the prior art. A notice to that affect is earnestly solicited.

Information Disclosure Statements

It is noted that the Office did not acknowledge receipt of Applicants' Sixth Information Disclosure Statement (received by the Office prior to the present Detailed Action on 05 October 2004⁷ as evidenced by return postcard, a copy of which is included herein as Appendix A) or consideration of the references therein. Acknowledgement and consideration of the Sixth Information Disclosure Statement at the Office's earliest convenience is requested.

Request For Telephonic Interview

Clearly, there are differences between the present invention and the cited reference(s) involving patentable subject matter. These differences are believed

⁷ The Sixth Information Disclosure Statement was admitted by the Examiner, during the aforementioned telephone conference of 06 December 2004, to be contained within the IFW system of the Office and dated before the mailing of the Detailed Action, although curiously not listed in PALM.

by the Applicants to be properly defined in the present Claims. The Examiner is requested to call Applicants' attorney (per the provisions of M.P.E.P. §713) to discuss any further problems or suggest solutions in defining the present invention in order to expedite the case towards allowance before issuing a final Office Action.

Favorable consideration is requested.

Respectfully submitted,



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